



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,156	11/01/2001	Norihiro Nanba	1232-4783	4791

27123 7590 06/03/2002
MORGAN & FINNEGAN, L.L.P.
345 PARK AVENUE
NEW YORK, NY 10154

EXAMINER

CHOI, WILLIAM C

ART UNIT	PAPER NUMBER
----------	--------------

2873

DATE MAILED: 06/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/016,156

Applicant(s)

NANBA, NORIHIRO

Examiner

William C. Choi

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1,2,4,8,10-15 and 18-20 is/are rejected.
- 7) ☐ Claim(s) 3,5-7,9 and 16-17 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 01 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on November 2, 2000. It is noted, however, that applicant has not filed a certified copy of the Japanese application as required by 35 U.S.C. 119(b).

Information Disclosure Statement

Receipt of the Information Disclosure Statement (IDS) with the copies of the references cited therein was received on January 31, 2002. An initialized copy of the IDS is enclosed with this office action.

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

Claim 11 is objected to because of the following informalities: In lines 6 and 7 of claim 11, applicant claims "N3n" to "be a refractive index", but does not specifically disclose for which lens element. For purposes of examination, it was assumed that applicant meant for lines 5 and 6 to read, "N3n be a refractive index of the negative lens

element of the cemented lens of said third lens unit" as supported by the tables.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 11 and 16 (and dependent claim 17) are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, with respect to these claims, applicant discloses the limitation of the zoom lens satisfying the condition: $0.8 < f_{3n}/f_3 < 1.7$. However, f_{3n} , indicated as being "a focal length of the negative lens element", would require it to have a negative value and f_3 , indicated to be a "focal length of said (positive) third lens unit", would require it to have a positive value. Therefore, f_{3n}/f_3 would exhibit a negative value, which would not satisfy the condition set forth above. For purposes of examination, the assumed meaning is the absolute value of the condition.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 1, 8, 11, 13-15 and 18-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Tochigi.

Regarding claim 1, Tochigi, specifically with respect to Numerical Example 1 and Figure 1, discloses a zoom lens comprising, in order from an object side to an image side: a first lens unit of a negative optical power (column 5, lines 14-15, Figure 1, "L2"); a second lens unit of a positive optical power (column 5, lines 15-16, Figure 1, "L3"); and a third lens unit of a positive optical power (column 5, lines 16-17, Figure 1, "L4"), said third lens unit having a cemented lens formed by cementing a positive lens element to a negative lens element (column 5, line 67 – column 6, line 3, Figure 1, "L4") and moving along an optical axis for zooming (column 5, lines 29-36, Figure 1, "L4"), wherein a space between said first and second lens unit decreases, and a space between said second lens unit and said third lens unit increases in zooming from a wide angle end to a telephoto end (column 9, lines 59-60, re "D14" and "D21"), and satisfying the number of lens elements condition as set forth (Figure 1).

Regarding claim 8, Tochigi discloses a lens surface of said second lens unit (Figure 1, "L3"), which is located nearest the object side having a convex shape on the object side and has aspherical shape (Example 1). This aspherical surface would

inherently weaken a converging effect from the optical axis to a periphery based upon the similarity in structure between Tochigi and that of the claimed invention.

Regarding claim 11, the zoom lens of Tochigi satisfies the conditional expressions as set forth.

Regarding claims 13 and 14, the zoom lens of Tochigi will inherently satisfy the conditions as set forth in these claims, this being reasonably based upon the large ranges claimed and the similarity in structure between Tochigi and that of the claimed invention.

Regarding claim 15, Tochigi discloses said third lens unit moving along the optical axis for focusing (column 5, lines 29-36, Figure 1, "L4").

The conditions of claims 18-20 would be met since Tochigi discloses the invention to be used in conjunction with a video camera (column 1, lines 6-12).

Claims 1-2, 4, 10-15, 18-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Mihara.

Regarding claim 1, Mihara, specifically with respect to Example 3 and Figure 3, discloses a zoom lens comprising, in order from an object side to an image side: a first lens unit of a negative optical power (Abstract and page 6, section [0084], Figure 3, "G1"); a second lens unit of a positive optical power (Abstract and page 6, section [0084], Figure 3, "G2"); and a third lens unit of a positive optical power (Abstract and page 6, section [0084], Figure 3, "G4"), said third lens unit having a cemented lens formed by cementing a positive lens element to a negative lens element (Figure 3, "G4") and moving along an optical axis for zooming (Page 6, section [0084], Figure 3, "G4"),

wherein a space between said first and second lens unit decreases, and a space between said second lens unit and said third lens unit increases in zooming from a wide angle end to a telephoto end (Pages 6-7, section [0100], Example 3), and satisfying the number of lens elements condition as set forth (Figure 3).

Regarding claims 2, 4, 10-15 and 18-20, Mihara discloses further having the claimed structure and/or satisfying the claimed conditions (see Figure 3, Example 3).

Allowable Subject Matter

Claims 3, 5-7, 9 and 16-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: in reference to the allowable claims, none of the prior art either alone or in combination disclose or teach of the claimed limitations to warrant a rejection under 35 USC 102 or 103.

The prior art fails to teach a combination of all the claimed features as presented in claims 3, 5-7, 9 and 16-17: a zoom lens comprising, in order from an object to image side: a negative first lens unit; a positive second lens unit; a positive third lens unit having a cemented lens as claimed, wherein a space between said first and second lens units decreases and a space between said second and third lens units increases in zooming from a wide angle end to a telephoto end and satisfying the lens elements

condition as claimed and specifically further comprising the structural limitations set forth in the claims stated above.

Prior Art Citations

Mukaiya et al is being cited herein to show a zoom lens that would read on or make obvious a number of the above rejected claims, however, such rejections would have been repetitive.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Choi whose telephone number is (703) 305-3100. The examiner can normally be reached on Monday-Friday from about 9:00 am to 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached on (703) 308-4883. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3431 for regular communications and (703) 305-3432 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.


Application/Control Number: 10/016,156

Page 8

Art Unit: 2873

W. C. .

William Choi
Patent Examiner
Art Unit 2873
May 30, 2002



JORDAN SCHWARTZ
PRIMARY EXAMINER